

### **REMARKS/ARGUMENTS**

In response to the Office Action dated June 13, 2006, claims 1, 2 and 16 are amended. Claims 1-7, 9-11 and 13-18 are now active in this application. No new matter has been added.

### **REJECTION OF CLAIMS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH**

I. Claims 1-7, 9-11 and 13-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner maintains that "an inner edge" on line 4 of claim 1 "renders the claims indefinite because it is unclear which element of the invention includes the inner edge to which the applicant is referring".

The rejection of claims 1-7, 9-11 and 13-18 as being indefinite on this basis is respectfully traversed.

The pivotal issue generated by a rejection under the second paragraph of 35 U.S.C. § 112, second paragraph, is whether one having ordinary skill in the art, with the supporting specification in hand, would be able to ascertain the scope of the claims with reasonable precision. *In re Moore*, 439 F.2d 1232, 169 USPQ 236 (CCPA 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). It should be emphasized that unpatented claims are reasonably construed in light of the supporting specification. *In re Okuzawa*, 537 F.2d 545, 190 USPQ 464 (CCPA 1976); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, reasonable precision is all that is required. See, for example, *U.S. v Telectronics Inc.*, 857 F.2d 778, 8 USPQ2d 1217; *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986); *In re Kroekel*, 504 F.2d 1143, 183 USPQ 610 (CCPA 1974).

The Examiner's problem concerning clarity results from the fact that the Examiner is reading the claims in a vacuum and not in light of the specification as is required. In this regard, the second full paragraph on page 3 of the specification includes the following description:

Further, the inner panel 6 has a central opening of a notched shape that gradually becomes narrower from an upper edge toward the lower

side thereof. Namely, the inner panel 6 has a substantially U-shaped configuration in a side view. The base plate 7 is disposed between both panels 2 and 6. The door trim 8 is attached to the vehicle compartment inner side of the inner panel 6. An inner edge 9 of the inner panel 6 and a peripheral edge 10 extending from each of vehicle front and rear sides to a lower side of the base plate 7 are joined by screws or the like.

With the above legal precedents in mind, as well as the above referenced description, together with FIG. 1, it is submitted that when the claim language is read in light of the specification, an artisan would readily understand the metes and bounds of the invention. Therefore, claims 1-7, 9-11 and 13-18 are definite and it is respectfully urged that the rejection be withdrawn.

**II.** The Examiner asserts also that "the door glass" recited at line 2 of claim 2 lacks antecedent support.

By this response, claim 2 has been amended to change "the" to "a". Consequently, withdrawal of the rejection of claim 2, as amended, under 35 U.S.C. § 112, second paragraph, is respectfully solicited.

#### **REJECTION OF CLAIMS UNDER 35 U.S.C. § 102 AND § 103**

**I.** Claims 1-4 and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by Okamoto et al. (USPN 6,139,088).

Claims 1, 5, 6, 9-11, 13-16 and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Sakaguchi et al. (USPN 6,640,497).

**II.** In the Response to Arguments portion of the Office Action, the Examiner asserts that "Claim 1 recites the 'base plate being formed of a single piece element and having a peripheral edge'. Accordingly, claim 1 only requires the base plate to include a single piece element *rather than requiring a single piece element form the entire base plate*. Therefore, a base plate which has a plurality of single piece element, such as Okamoto et al., would anticipate claim 1.

Additionally, the recitation only requires the base plate and not the single piece element to include the peripheral edge (emphasis added)."

The Examiner further asserts that "Claim 1 only requires the base plate to cover a portion of the central opening. Claim 1 also requires the base plate to cover the entirety of said portion. As shown in figure 3 of Sakaguchi et al., the base plate 40 at least covers the portion of the opening adjacent the lower portion 22 of the inner panel and the base plate covers the entirety of said portion."

To expedite prosecution, independent claim 1 has been amended to recite, inter alia:

a base plate to which at least a window regulator module is assembled, a single piece element forming the entire base plate with the base plate having a peripheral edge adapted to be attached to the inner edge of the inner panel, such that the peripheral edge makes contact with the inner edge so that the base plate wholly covers the central opening of the inner panel.

Independent claim 16 has been similarly amended.

Thus, amended independent claim 1 now makes it clear that a single piece element forms the entire base plate and the base plate wholly covers the central opening of the inner panel (see the last portion of the second full paragraph on page 3). In view of the current recitations, the distinction noted by the Examiner regarding "the recitation requires the base plate and not the single piece element to include the peripheral edge" is no longer relevant as the single piece element *forms the entire base plate*.

As neither Okamoto et al. nor Sakaguchi et al. discloses or suggests the features now recited in amended independent claim 1 and Sakaguchi et al. does not disclose or suggest the features now recited in amended independent claim 16, amended independent claim 1 is patentable over Okamoto et al and Sakaguchi et al., and amended independent claim 16 is patentable over Sakaguchi et al. Therefore, the allowance of claims 1-7, 9-11, 13-16 and 18, as amended, is respectfully solicited.

**III.** Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakaguchi et al. in view of Baldamus et al. (USPN 4,648,208).

However, claim 17 depends from amended independent claim 1, which is patentable over Sakaguchi et al. Consequently, claim 17 is patentable over Sakaguchi et al. also, even considered in view of Baldamus et al. Therefore, the allowance of claim 17 is respectfully solicited also.

### **CONCLUSION**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Edward J. Wise (Reg. No. 34,523) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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